

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

NORTHRUP et al.

Appln. No. 08/482,933



Group Art Unit: 1631

Filed: June 7, 1995

Examiner: A. Marschel

FOR: MICROFABRICATED REACTOR

DECLARATION OF SCOTT A. TAPER

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Scott A. Taper, declare and state as follows:

1. I am familiar with the invention disclosed and claimed in the subject Appln. No. 08/482,933, which names Dr. M. Allen Northrup and Dr. Richard M. White (hereinafter "Northrup and White") as joint inventors. The invention was made by Northrup and White in connection with their joint research work at the Berkeley Sensor and Actuator Center ("BSAC") and the University of California, Berkeley. At that time, I was employed by the University of California as a Licensing Associate and it was my responsibility to consider and license inventions resulting from research carried out at BSAC. My specific responsibilities included, *inter alia*, receiving and reviewing invention disclosures given to me by researchers, ordering prior art searches to determine the patentability of inventions so disclosed, overseeing the preparation and filing of patent applications, and licensing and maintaining resulting patent property. This required me to be fully familiar with the various research projects at BSAC, including the research

that was being done by Northrup and White on the invention disclosed in Appln. No. 08/482,933.

2. I am directly aware as a result of disclosure made to me by Northrup and White that the invention described and claimed in Appln. No. 08/482,933 was conceived by Northrup and White and reduced to practice prior to May 1, 1992. The invention and the related research and records thereof were disclosed to me prior to May 1, 1992. I also instituted searches needed to determine patentability of the invention and steps towards preparing a patent application thereon by Mr. William J. Egan III, an outside patent counsel for the University of California, which were also undertaken prior to May 1, 1992. Preparation, completion and filing of the application were diligently pursued from prior to May 1, 1992 up to its filing date on August 31, 1992.

3. Attached as Northrup Exhibit A is an Invention and Technology Disclosure entitled "Chemical Flow and Reactor Microinstrumentation" prepared and signed by Northrup and White prior to May 1, 1992. The disclosure is identified by reference to "Case Number 92-011" which I recall identifies the subject invention.

4. I am familiar with the handwriting of Dr. M. Allen Northrup and Dr. Richard M. White, and I can confirm that these individuals signed the Invention and Technology Disclosure form (Northrup Exhibit A) prior to May 1, 1992.

5. I also confirm of my own knowledge and familiarity with the research work done by Northrup and White that the invention described in Northrup Exhibit A, as noted in Item 4C of the disclosure form, was reduced to practice prior to May 1, 1992.

6. I note further that an earlier disclosure was submitted to me by Northrup and White some months prior to Northrup Exhibit A. This is attached as Northrup Exhibit B.

I confirm that my signature appears at the bottom, right-hand side of page 1 of Northrup Exhibit B and was applied prior to May 1, 1992. I can also confirm that Northrup and White both signed the disclosure (Northrup Exhibit B) prior to May 1, 1992 and also prior to their submission to me of Northrup Exhibit A.

7. Subsequent to my receipt of invention disclosures Northrup Exhibit A and Northrup Exhibit B, I instructed the University's outside patent counsel (William J. Egan III, then of the Heller, Ehrman, White & McAuliffe law firm) to institute a search of the prior art to determine patentability of the Northrup and White invention. See my letters attached as Northrup Exhibits C and D, respectively. These letters were sent prior to May 1, 1992.

8. Mr. Egan acknowledged my instructions to conduct the requested search by letter dated prior to May 1, 1992 (Northrup Exhibit E). The search results were reported to me by Mr. Egan prior to May 1, 1992. See my letter (Northrup Exhibit F) referring to Mr. Egan's search report. In that letter (Northrup Exhibit F), I asked Mr. Egan to extend his search.

9. Northrup Exhibit G is a letter from Northrup and White to me with a further invention disclosure. This letter and the disclosure attached thereto were submitted to me prior to May 1, 1992 and expanded on the invention disclosure earlier given to me. I believe that at least one of the disclosures represented by Northrup Exhibit G or Northrup Exhibit A or B were used as a basis for the searches carried out by Mr. Egan.

10. I recall having numerous discussions with Northrup and White regarding their invention, and also with Mr. Egan, prior to May 1, 1992 and I know that, prior to that date, the invention had been reduced to practice and a decision had been reached to

file a patent application through Mr. Egan's firm. I therefore arranged for Mr. Egan and his associate (Mr. Laurence J. Shaw) to meet with me and Drs. Northrup and White to provide Mr. Egan and his associate with any further material they needed to prepare an appropriate patent application. We met with Mr. Egan and his associate on May 12, 1992, the earliest date when Northrup and White and I could meet with Mr. Egan and his associate to consider what further information was needed for completion of the patent application. Mr. Egan and his associate then prepared and finalized the patent application for filing on August, 31, 1992 following consideration of several draft applications with the inventors. I believe the preparation and the filing of the application proceeded diligently from prior to May 1, 1992 up to its filing.

11. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any patent issued thereon.

Scott A. Taper

Date: _____